

NIAD 201.3 DIV (10109394)REMARKS

Reconsideration of this application, as amended, is respectfully requested.

The Specification has been objected to for incorrectly stating the application's priority status. Accordingly, the Specification has been amended to reflect the priority status of the application. Specifically, the sentence, "[t]his Application is a divisional of application Serial No. 09/302,812, filed on April 30, 1999, now U.S. Patent No. 6,333,148," has been added to the first paragraph of the first page of the Specification per the Examiner's suggestion, and additional minor changes have been made. Thus, it is believed that this amendment overcomes the objection to the Specification.

Also, the Declaration filed on September 2, 2004 has been objected to because the it states that Nasreen Aboul-Ela "was not a co-inventor." With respect to this objection, the Declaration has been amended to state that "Nasreen Aboul-Ela...was not a co-inventor." (See the Declaration paragraph 3). Thus, it is believed that this change overcomes the objection to the Declaration.

Claims 67-80 remain rejected under 35 USC 103(a) as being unpatentable over Lin et al. in further view of Campbell, A.M. for the reasons set forth in the June 4, 2004 non-final office action. With respect to this rejection, the Declaration has been amended, as noted supra. Thus, it is believed that this change overcomes the rejection of claims 67-80 for the reasons set forth in our September 2, 2004 amendment.

That is, with respect to this rejection, the instant application claims a priority date of May 1, 1998. Lin et. al. was published less than one year prior to the priority date, May 2, 1997. Attached hereto is a declaration in accordance with In re Katz, 215 USPQ 14 (CCPA 1982) establishing that Nasreen Aboul-Ela was not and is not a co-inventor. All other authors of Lin et. al. are co-inventors. Thus, according to In re Katz, the rejection cannot be maintained as a matter of law.

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It is understood that the attached declaration has been used before in a related patent case, Application Serial No. 09/511,477, now U.S. Patent No. 6,337,202. It is submitted, however, that Nasreen Aboul-Ela did not contribute to the inventive concept, but only followed instructions and performed experiments. Nasreen Aboul-Ela was not an inventor in 1997, nor in 2000, nor is she an inventor now. This fact has not changed. Thus, use of the same declaration that was used in October of 2000 is proper.

Furthermore, Nasreen Aboul-Ela is not the inventor of the protein. Thus, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to use the encoded PARG for the purposes of generating antibodies that specifically bind to the claimed peptides, because the protein was not described "by others" in a printed publication before the application thereof by the Applicants. i.e., that Nasreen Aboul-Ela is not a co-inventor, and this a finding of obviousness is inappropriate.

Moreover, claim 71 has been objected to because the claim appears to be missing a word after "hybridizes." With respect to this rejection, claim 71 has been amended to add the word "to" after "hybridizes." Additionally, the letter "s" has been removed from sequences, so that the singular "sequence" remains in the claim. Thus, it is believed that this change overcomes the objection to claim 71.

Further, a new rejection has issued rejecting claims 67-80 under 35 USC 112, first paragraph, as failing to comply with the written description requirement, i.e., the specification and claims as originally filed do not lend support for the limitation of an isolated antibody that binds to a protein which catalyzes the release of ADP-ribose from an ADP ribose polymer. It is believed that this rejection is misplaced.

With respect to the new rejection, independent claims 67, 70, and 72 have been amended to qualify "protein," i.e., a protein, which is a poly(ADP-ribose) glycohydrolase. Additionally, support for the clause "catalyzes the release of ADP-ribose from an ADP ribose polymer", can be found, for example, on page 41, last paragraph through 42, first paragraph, and in figure 9. Also, support for this clause can

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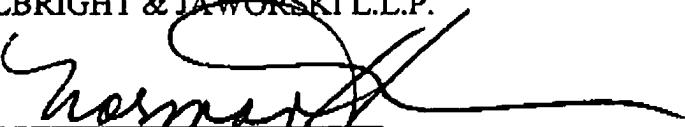
be found in the "Technical Field and "Background of the Invention" on page 1 through page 2, as well as in figure 1. Therefore, this rejection should be withdrawn.

It is, therefore, believed that these claims and their dependent claims are allowable.

In view of the foregoing, withdrawal of all rejections and allowance of this application are respectfully requested.

Respectfully submitted,

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